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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,613	08/13/2001	Galen M. Gareis	6500-1801.2	9701

7590 08/27/2003

LEE, MANN, SMITH, MCWILLIAMS, SWEENEY & OHLSON
P.O. BOX 2786
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EXAMINER

MAYO III, WILLIAM H

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,613

Applicant(s)

GAREIS, GALEN M.

Examiner

William H. Mayo III

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-- Th MAILING DATE of this communication appears on th cover she t with th correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4 is/are rejected.
- 7) ☒ Claim(s) 3,5 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Oath/Declaration

1. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. Specifically, the major axis having a length larger than the length of the minor axis was not claimed in the parent case. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-22 of U.S. Patent No. 6,297,454. Although the conflicting claims are not identical, they are not patentably distinct from each other because with respect to claim 1 of the patent application, Gareis recites in claim 1 of the patent, a communication cable separator spline comprising a longitudinally extending spline having a plurality of spaced longitudinally extending open pockets, a cross section of the spline having a major and minor axis, at least one pocket being on a major axis, and at least one pocket being on the minor axis and wherein the ratio of length of the major axis to the length of the minor axis is 0.100:0.010 to 0.050:0.030 (i.e. the length of the major axis is greater than the length of the minor axis).

However, Gareis doesn't necessarily disclose the communication cable having twisted pairs (claim 1).

With respect to claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the communication cable separator spline of Gareis to be utilized with twisted pairs of a communication cable, since it is well known in the art of cables that communication cables commonly utilized twisted pair conductors for the purpose of reducing cross talk between the conductor pairs and it appears that Gareis would work well with or without the modification.

With respect to claims 2-3 of the patent application, Gareis discloses in claim 20, a communication cable separator spline wherein the major axis is substantially perpendicular to the minor axis and each of the pockets longitudinally extends

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substantially parallel to each other, wherein each of the pockets have a cross section area which is 75% or less than a cross sectional area of a circular envelop of a cable to be placed in the pockets. With respect to claim 4 of the patent application, Gareis discloses in claim 22, a communication cable separator spline, wherein the spline has a first, second, third, and fourth spaced longitudinally extending open pocket, wherein a cross section of the spline has a major axis and a minor axis, and wherein the first and second pockets (have substantially the same cross sectional area and the third and fourth pockets have substantially the same cross sectional area. With respect to claim 5 of the patent application, Gareis discloses in claims 20 & 22 a communication cable separator spline, wherein the major axis is substantially perpendicular to the minor axis (10), the third and fourth pockets (30 & 50 respectively) have substantially the same cross sectional area (Fig 1) and the first (40), second (60), third (30), and fourth (50) spaced longitudinally extending open pockets are substantially parallel to each other (Fig 1). With respect to claim 6 of the patent application, Gareis discloses in claim 21, a communication cable separator spline, wherein the first (40) and second (60) pockets have a depth that is equal to the depth of the third (30) and fourth (50) pockets.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al (JP Pat Num 4-332406, herein referred to as Ikeda). Ikeda discloses spacer type cable (Figs 1-4). Specifically, with respect to claim 1, Ikeda discloses a twisted pair cable separator spline (Fig 1) capable of being used with communication cable (Page 2, line 7) and comprising a longitudinally extending spline (5) having a plurality of spaced longitudinally extending pockets (denoted as 30 & 40), a cross section of the spline (5) having a major axis (left to right, denoted as 20) and a minor axis (top to bottom, denoted as 10) and wherein at least one pocket (40) is on the major axis (20) and at least one pocket (30) is on minor axis (10). With respect to claim 2, Ikeda discloses that the major axis (20) is substantially perpendicular to the minor axis (10) and each of the pockets (30 & 40) longitudinally extends substantially parallel to each other (Fig 1). With respect to claim 4, Ikeda discloses that the spline (5) has a first (40), second (60), third (30), and fourth (50) spaced longitudinally extending open pocket (Figs 1), wherein a cross section of the spline (5) has a major axis (20) and a minor axis (10), and wherein the first and second pockets (40 & 60 respectively) have substantially the same cross sectional area (Figs 1) and the third and fourth pockets (30 & 50 respectively) have substantially the same cross sectional area (Fig 1).

However, Ikeda doesn't necessarily disclose the major axis having a length greater than a length of the minor axis (claim 1).

With respect to claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cable separator spline of Ikeda to comprise the major axis to have a longer length than the minor axis wherein the first

and second pockets will have a depth greater than the depth of the third and fourth pockets, since Ikeda teaches that the groove shape is not limited to the explained configuration and states that all types of variations in the design are included in the scope of the present invention and since it has been held that more than mere change of form or rearrangement of parts is necessary for patentability. *Span-Deck Inc v Fab-Con, Inc*, (CA 8, 1982) 215 USPQ 835.

Allowable Subject Matter

5. Claims 3 and 5-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: This invention deals with a communication cable separator spline comprising pockets having a cross-sectional area which is 75% or less than a cross-sectional area of a circular envelope of an insulated cable to be placed in the pockets (claims 3 & 5). This invention also deals with a communication cable having a longitudinally extending spline comprising first, second, third, and fourth pockets having a cross-sectional area which is 25% to 75% of the cross-sectional area of a circular envelope of an twisted pair cable in the pockets (claim 6).

Response to Arguments

7. Applicant's arguments, see paper number 16, filed July 31, 2003, with respect to claims 3 and 5-6 have been fully considered and are persuasive. The 35 USC 103(a) rejection of claims 3 and 5-6 as being unpatentable over Ikeda (JP Pat Num 4-332406) has been withdrawn. However, the applicant argues the following

- A) There is no suggestion to modify the reference (i.e. Ikeda) to comprise a major axis having a length greater than the minor axis.
- B) The examiner has improperly rejected the claims based on applicant's disclosure, which is improper hindsight.

In response argument A, the examiner respectfully traverses. The examiner recognizes that obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ikeda clearly teaches that the shape of the groove may be modified to comprise all types of variations. Specifically, on page 5, lines 8-14, under the heading "(Other variations)", Ikeda states

"Up to this point, a representative example as shown in Figure 1 with the shape, groove shape, number of grooves, and the like of the spacer (1) has been explained, but it is not limited to this, and equivalent results are

obtained even if the cross section is square or polygonal for the spacer shape. That is to say, it goes without saying that all types of variations in the design are included within the scope of the present invention."

Based on this teaching, it would have been obvious to modify the shape of the groove of Ikeda to be of any shape, such as an oval, which would produce the major axis being longer than the minor axis.

With respect to argument B, the examiner respectfully traverses. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Therefore, the examiner respectfully submits that the 35 USC 103 rejection is proper and just.

Conclusion

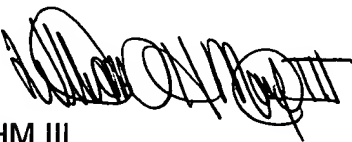
8. Based on the newly submitted rejection, the examiner respectfully submits that this action is non-final.

Communication

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (703) 306-9061. The examiner can normally be reached on M-F 8:30 a. m. -6:00 p.m. (alternating Friday's off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308-3682. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read 'W. H. Mayo III', with a stylized flourish at the end.

WHM III
August 20, 2003